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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/715,909 11/17/00 FLANNAGAN

R 35718/204664

029122 HM12/1010  
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EXAMINER

HOLBROOK, P

ART UNIT

PAPER NUMBER

1647

DATE MAILED:

10/10/01

Please find below and/or attached an Office communication concerning this application or proceeding.

**Commissioner of Patents and Trademarks**

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/715,909	FLANNAGAN ET AL.
	Examiner Pamela G Holbrook	Art Unit 1647

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 11/17/2000.

2a) This action is FINAL.                            2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-25 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) \_\_\_\_\_ is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claims 1-25 are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved.

12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. § 119

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

#### Attachment(s)

15) Notice of References Cited (PTO-892)

16) Notice of Draftsperson's Patent Drawing Review (PTO-948)

17) Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_

18) Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_

19) Notice of Informal Patent Application (PTO-152)

20) Other: \_\_\_\_\_

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-3,7,8, 10-18 drawn to the nucleic acid, vectors and host cells of SEQ ID NO: 1 encoding SEQ ID NO: 2, classified in class 536, subclass 23.5, class 435, subclass 320.1, class 435, subclass, 325.
- II. Claims 1-3,7,8, 10-18 drawn to the nucleic acid, vectors and host cells of SEQ ID NO: 3 encoding SEQ ID NO: 4, classified in class 536, subclass 23.5, class 435, subclass 320.1, class 435, subclass, 325.
- III. Claims 1-3,7,8, 10-18 drawn to the nucleic acid, vectors and host cells of SEQ ID NO: 5 encoding SEQ ID NO: 6, classified in class 536, subclass 23.5, class 435, subclass 320.1, class 435, subclass, 325.
- IV. Claims 4-6, drawn to the protein of SEQ ID NO: 1 encoding SEQ ID NO: 2, classified in class 530, subclass 858.
- V. Claims 4-6, drawn to the protein of SEQ ID NO: 3 encoding SEQ ID NO: 4, classified in class 530, subclass 858.
- VI. Claims 4-6, drawn to the protein of SEQ ID NO: 5 encoding SEQ ID NO: 6, classified in class 530, subclass 858.
- VII. Claim 9, drawn to an antibody to SEQ ID NO: 2 encoded by SEQ ID NO: 1, classified in class 530, subclass 388.22.

VIII. Claim 9, drawn to an antibody to SEQ ID NO: 4 encoded by SEQ ID NO: 3, classified in class 530, subclass 388.22.

IX. Claim 9, drawn to an antibody to SEQ ID NO: 6 encoded by SEQ ID NO: 5, classified in class 530, subclass 388.22.

X. Claim 19, drawn to a method for screening for ligand using the protein of SEQ ID NO: 1 encoding SEQ ID NO: 2, classified in class 435, subclass 7.1.

XI. Claim 19, drawn to a method for screening for ligand using the protein of SEQ ID NO: 3 encoding SEQ ID NO: 4, classified in class 435, subclass 7.1.

XII. Claim 19, drawn to a method for screening for ligand using the protein of SEQ ID NO: 5 encoding SEQ ID NO: 6, classified in class 435, subclass 7.1.

XIII. Claims 20-25, drawn to a method to screen for ligand using a cell expressing the protein of SEQ ID NO: 1 encoding SEQ ID NO: 2 classified in class 435, subclass 7.21.

XIV. Claims 20-25, drawn to a method to screen for ligand using a cell expressing the protein of SEQ ID NO: 3 encoding SEQ ID NO: 4, classified in class 435, subclass 7.21.

XV. Claims 20-25, drawn to a method to screen for ligand using a cell expressing the protein of SEQ ID NO: 5 encoding SEQ ID NO: 6 classified in class 435, subclass 7.21.

2. The inventions are distinct, each from the other because of the following reasons:

Inventions I-III, IV-VI and VII-IX are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are drawn to completely different products having completely different structures and biological functions which are not interchangeable and which require non-cohesive searches and considerations.

3. Inventions X-XII and XIII-XV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case, the different inventions are drawn to completely different method steps, using different compositions and having completely different outcomes. The method to screen for ligand based on binding to receptor protein requires detection of agents bound to membrane preparations or purified protein and requires a step to separate bound from free ligand whereas the method to screen for ligand using a cell expressing the protein involves measuring a biochemical change in a cell lysate or a response of the intact cell. .

4. Inventions IV-VI and X-XII are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: 1) the process for using the product as claimed can be practiced with another materially

different product or 2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the receptor protein can be used in a materially different process, such as the production of antibodies.

5. Inventions IV-VI and XIII-XV are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown:
  - 1) the process for using the product as claimed can be practiced with another materially different product or 2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the receptor protein can be used in a materially different process, such as the production of antibodies.
7. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
8. Because these inventions are distinct for the reasons given above and the search required for any single group is not required for any other group, restriction for examination purposes as indicated is proper.

9. The corresponding polynucleotides of Groups I-III, IV-VI, VII-IX, X-XII and XIII-XV are distinct, each from the other, because each individual sequence represents a structurally distinct entity that is capable of supporting a separate patent. The search and consideration of more than a single sequence constitutes an undue search burden on the office, given the ever-increasing size of databases.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(l).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pamela Holbrook whose telephone number is (703) 306-3221, Mon.- Fri. 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler, can be reached on (703) 308-6564.

The fax phone number for this Group is (703) 305-3014 or (703) 308-4242.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [yvonne.eyler@uspto.gov].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

October 9, 2001, 2001



YVONNE EYLER, PH.D  
SUPERVISORY PATENT EXAMINER  
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